

REMARKS

Claim 1 has been canceled.

New claims 2-11 are submitted for prosecution. Claims 2-11 are patterned after claims 2-4, 10, and 15-17 of commonly owned U.S. Patent No. 6,663,669, but add an additional element of a tibia prosthesis sized and configured to articulate with the ankle replacement prosthesis.

Claims 2-11 remain pending in the application.

Entry of this Preliminary Amendment and allowance of claims 2-11 is respectfully requested.

Respectfully Submitted,

By Patricia A. Limbach

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RYAN KROMHOLZ & MANION, S.C.
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18 June 2004
Customer No.: 26308
Re: 10/700,283-CP DIVISIONAL Preliminary Amendment

Enclosures: Amendment Transmittal Letter
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FILED IN THE UNITED STATES PATENT & TRADEMARK OFFICE

PAL/lsw

Serial No.: 10/700,283

Title: Ankle Replacement System

Applicant: Reiley

Date Mailed: 18 June 2004

via First Class Mail

Docket #: 9414.17206-CIP DIV

Enclosures: Amendment Transmittal Letter; Preliminary Amendment;
Transmittal of Information Disclosure Statement; Information
Disclosure Statement; copies of references cited; return postcard



Attachment B

REMARKS

The Abstract of the Disclosure is objected to because of undue length. MPEP 608.01(b) provides in part that "[t]he abstract should be in narrative form and generally limited to a single paragraph within the range of 50 to 150 words. The abstract should not exceed 25 lines of text." The abstract in the instant case as originally filed is a single paragraph comprising 18 lines of text and 139 words. Therefore, Applicant believes this objection is improper. However, in the interest of advancing prosecution, the Abstract has been amended to abbreviate its length.

The Office Action indicates that claim 1 is pending. Applicant filed a Preliminary Amendment on June 18, 2003 canceling claim 1 and presenting new claims 2-11. A copy of the Preliminary Amendment is attached (Attachment A). A copy of the postcard acknowledging receipt of the Preliminary Amendment by the USPTO is also attached (Attachment B).

Claim 1 is rejected based on the doctrine of obviousness-type double patenting over claims 1, 11, 14 and 15 of commonly owned US. Patent No. 6,663,669 (the '669 Patent). Claim 1 is also rejected under 35 U.S.C. §102(b) based on Fournol et al. FR 2,700,462 (Fournol '462). Claim 1 has been canceled.

Claims 2-11 remain pending in the application. Claims 2-11 are patterned after claims 2-4, 10, and 15-17 of the '669 Patent, but add an additional element of a tibia prosthesis sized and configured to articulate with the ankle replacement prosthesis. Applicant does not believe that claim 2-11 present a double patenting issue with respect to the '669 Patent. The claims are not directed to the same invention under 35 U.S.C. §101 (no statutory double patenting). Furthermore, the differences defined are non-obvious (no obviousness-type non-statutory double patenting).

In addition, Fournol '462 does not teach or suggest an ankle joint prosthesis having a superior portion including a component having a Morse Taper and sized and configured to engage another prosthesis element, as defined by independent claim 2. Fournol '462 also does not teach or suggest an ankle joint prosthesis having a superior portion that includes a component sized and arranged to support a convex artificial joint replacement without extending into the tibia, as defined by independent claims 6 and 10. Dependent claims 3-5, 7-9 and 11 further define the subject matter of the independent claims and are therefore also believed to be allowable over the cited reference.

Reconsideration in view of the foregoing amendments and remarks and allowance of claims 2-11 is respectfully requested.

Respectfully Submitted,

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Patent 1/28-02 DIV 100111 Amendment A

Enclosures: Amendment Transmittal Letter
Attachment A
Attachment B
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